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EXAMINER				
GRESO, AARON J				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/552,655

Applicant(s)

FLACHSMANN ET AL.

Examiner

AARON GRESO

Art Unit

1796

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 March 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3,5,8,10,11,13,15,18 and 19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3,5,8,10,11,13,15,18 and 19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ ~~Notice of Informal Patent Application~~
- 6) ☐ Other: _____

DETAILED ACTION

The indicated allowability of Claims 10 and 15 is withdrawn in view of the newly discovered reference(s) to *Karr Hunt et al. (US 2060733)*. The examiner regrets any delay in submitting the reference. Rejections based on the newly cited reference(s) follow.

Any rejections and/or objections made in the previous Office Action and not repeated below, are hereby withdrawn.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

The new grounds of rejection set forth below are necessitated by applicant's amendment filed on 02 March 2010.

In particular, Claims 3 and its dependent Claims 8, 10, 11, 13, 15; and Claim 5 and its dependent Claims 18-19 have been amended adjust the Markush selections and further to associate Claims with a method.

The newly amended claims were not present at the time of the preceding action. For this reason, the present action is properly made final.

Claim Rejections - 35 USC § 102/103

Claim 3 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over *Karr Hunt et al. (US 2060733)*.

Karr Hunt et al. (col 2-3 lines 33-50 and 1-6 respectively) disclose carbamate materials added to compositions; the genus is presented in Figure 1 below:



Figure 1. Genus of *Karr Hunt et al.* X is Oxygen or Sulfur.

As the fragrance ingredient is met, the reference discloses or inherently discloses all the property limitations of the applicable Claim when X is Oxygen.

As the reference discloses a method for adding carbamate material to a composition and as the reference's materials are members within the Claim 3 genus it would be expected that the inherent fragrant properties of the materials provide for the property limitations indicated for Claims 3.

Further, the reference teaches a genus which places a claimed species in the possession of the public as in *In re Schaumann*, 572 F2d 312, 197 USPQ 5 (CCPA 1978), and [the] species would have been obvious even if the genus were not sufficiently small to justify a rejection under 35 USC 102. See MPEP § § 2131.02 and 2144.08 for more information on anticipation and obviousness of species by a disclosure of a genus.

Claim Rejections - 35 USC § 103

Claim 5 is rejected under 35 U.S.C. 103(a) as being obvious over *Karr Hunt et al.* (US 2060733).

Karr Hunt et al. (col 2-3 lines 33-50) disclose carbamate materials added to compositions; the genus is presented in Figure 1 above.

The genus indicates a trend of R1, R2, and R3, materials comprising linear or branched alkanes from C1 to C18, phenyl, tolyl, or benzyl; X is oxygen or sulfur.

The reference does not specifically disclose the claimed materials of instant Claim 5.

On the other hand, the genus indicates a trend of R1, R2, and R3, materials comprising linear or branched alkanes or alkenes from C1 to C18, including methyl ethyl, propyl, butyl, amyl {pentyl}, decyl, dodecyl, cyclohexy, phenyl, tolyl, or benzyl; including N-methyl-N-phenyl ethyl carbamate (col 3 line 26) {taken as a demonstration allowing mixed variations of R1, R2, and R3 groups}; while X is indicated by the genus to comprise oxygen or only one other moiety.

Further, as the reference teaches a trend of linear materials starting from methyl, ethyl, propyl, decyl, dodecyl, octadecyl, the trend is taken to include linear R1-3 groups that would include C1 to C18 materials, this would also include C6, linear, or linear hexyl groups.

This would include the composition of Applicants' instant Claim 5 material that is identified as the chemical species; corresponding to the 14th entry from the top of Applicants' instant Claim 5; comprising ethyl, methyl, and hexyl R, R1 and R2 groups.

As the genus limits the moieties for X, R1, R2, and R3, the number of possible materials is finite. As the list is finite, and the readily identified materials comprising methyl, ethyl and hexyl groups, it would be obvious to one of ordinary skill in the art to choose any of the successful materials comprised by the limiting and successful genus boundaries as a successful chemical material with a reasonable expectation of success. See MPEP § 2131.02 and 2144.08 for more information on obviousness of species by a disclosure of a genus for the applications indicated by the reference.

The material would be expected to have inherent properties, including those identified by the Applicants. It is held that "Products of identical chemical composition can not have mutually exclusive properties." A chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure, the properties applicant discloses and/or claims are necessarily present. *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have chosen a chemical species, with inherent properties, within the genus and genus boundaries taught by *Karr Hunt et al.*; to obtain a carbamate with inherent properties with a reasonable expectation of success.

Claims 3, 5, 8, 10-11, 13, 15, 18-19 are rejected under 35 U.S.C. 103(a) as being obvious over *Finch et al. (US Ap 2001/0036907)* in view of *Karr Hunt et al. (US 2060733)*.

Finch et al. (page 1 paragraph [0001]-[0011], [0016]-[0017]; page 1-2 paragraph [0018], page 2 paragraph [0019]-[0020], [0025], Abstract, page 5 paragraph [0073]-[0076]) employs esterified cellulose, rebuild material that improves fragrance retention on fabrics that are laundered; the materials are indicated to be preferred as functioning as fragranting material for as long as possible.

The material is indicated to be placed into compositions (*page 6 paragraphs [0080]-[0085]*) and is indicated to be applicable to a wide range of fragrance materials (*page 5 paragraph [0076]*).

The reference does not further teach the employment of carbamate materials within the Claim 3, 5, 10, and for those of the Applicants' instant Claim 11 genus of materials comprised in the fragranting compositions.

On the other hand, *Karr Hunt et al.* discloses a genus of carbamate materials {see Figure 1 above} that are indicated to prevent the deterioration of esterified cellulose materials (*col 2-3 lines 33-50 and 1-6 respectively*). The carbamates is applied to fabric material in water (*pages 2-3 Examples 2-3*) and are indicated to be used in a process of adding the carbamate materials to cellulose materials (*page 3 claims 1-2*).

The materials indicated by *Karr Hunt et al.* would include the composition of Applicants' instant Claim 5, and instant Claim 10 material that is identified as the

chemical species; corresponding to the 14th entry from the top of Applicants' instant Claim 5 and Claim 10; comprising ethyl, methyl, and hexyl R, R1 and R2 groups.

Further as to Claim 11:

As the material genus of *Karr Hunt et al.*, indicate that R1-R3 comprise cyclohexyl and ethyl groups, the 1st composition with the cyclohexyl and ethyl moieties in the genus's R1, and R2, R3 respectively when X is Oxygen.

It would have been obvious to one of ordinary skill in the art at the time of the invention to have added a cellulose preserving material with inherent fragrance properties successfully employed with fabrics as taught by *Karr Hunt et al.*, to a fragrance retention enhancing compositions employed with cellulose materials in laundry applications, as taught by *Finch et al.*, that are also suggested by *Finch et al.* as being desired to provide fragrance material for as long as possible, with a reasonable expectation of success.

Claims 3 and 8 are rejected under 35 U.S.C. 103(a) as obvious over *Torii et al.* (US 3966903) in view of *Kaiser et al.* (US 4260526).

Torii et al. discloses compositions for hair waving comprising the following genus chemicals (Abstract) shown in Figure 1 below:



Figure 2. US 3966903 genus

In Figure 3, R₁, R₂, and R₃ are chosen from a group comprising, methyl, ethyl, and propyl groups. The formulations are not are not indicated to have an unpleasant odor (Abstract) when adding this material (col 3 lines 32-45).

The reference discloses a genus with an insufficient number of carbons for at least some of the combinations of methyl, ethyl or propyl groups for materials in Claims 3, 8, 11, 13.

On the other hand, when two of the R groups comprise ethyl groups and the third comprises a propyl group, or when two out of three R groups comprise propyl groups while the third group is an ethyl or a methyl, the materials identified conform to the requirements of instant Claim 3.

These genus attributes satisfy the instant Claim 3 genus and can be readily envisaged when R₁, R₂, and R₃ of the reference are each C₁-C₁₁ alkyl groups for the Claim 3 genus group a) for each R, R¹ and R² species comprise at least two propyl groups or at least one ethyl or methyl in combination with two propyl moieties.

Because the Applicants indicate that the materials are fragrant, it is taken that the materials are also added as fragrances or as fragrant materials without an unpleasant odor as the materials are within the genus of the Applicants. Case law holds that a material and its properties are inseparable. In re Spada, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990).

Further as to Claim 8:

The chemicals are indicated to be combined with other materials including perfumes (col 4 lines 46-52). The compositions are indicated to be used for hair waving

(col 1 lines 65-68) and this terminology is taken as indicating uses for hair, as a body care product; compositions are also indicated to be free from any unpleasant odor and this is taken to indicate that the compositions employing the genus chemicals are intended to be used because they enable a pleasant odor.

In addition, the reference indicates that other chemicals employed as hair treatment materials, also indicated as having no odor, include gamma valerolactone (col 3 line 28); gamma-valerolactone, that would be expected to be known in the art by one of ordinary skill, as a fragrance (per *Kaiser et al. US 4260526*, Example G col 14); the valerolactone material is classified along with ethyl N,N-dimethylcarbamate {a material comprised within the Reference's genus} (col 3 lines 25-26), as also a material with no unpleasant odor.

The material would be expected to have inherent properties, including those identified by the Applicants. It is held that "Products of identical chemical composition can not have mutually exclusive properties." A chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure, the properties applicant discloses and/or claims are necessarily present. *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990).

As the reference discloses a method for adding carbamate material to a composition; and as the reference's materials are members within the Claim 3 genus; it would be expected that the inherent fragrant properties of the materials provide for the property limitations indicated for Claims 3 and its dependent Claims 8.

Further, In view of the reference's recognition that a fragrance material and carbamate materials are equivalent and interchangeable, it would have been obvious to one of ordinary skill in the art to substitute a fragrance with a carbamate material with inherent odiferous properties and thereby arrive at the present invention. Case law holds that the mere substitution of an equivalent (something equal in value or meaning, as taught by analogous prior art) is not an act of invention; where equivalency is known to the prior art, the substitution of one equivalent for another is not patentable. See *In re Ruff* 118 USPQ 343 (CCPA 1958).

Claim 11 and 13 are rejected under 35 U.S.C. 103(a) as being obvious over *Torii et al.* (US 3966903).

Torii et al. discloses compositions for hair waving comprising the following genus chemicals (Abstract) shown in Figure 3 below:



Figure 3. US 3966903 genus>>

In Figure 3, R_1 , R_2 , and R_3 are chosen from a group comprising, methyl, ethyl, and propyl groups. These genus attributes satisfy the instant Claim 3 genus and can be readily envisaged when R_1 , R_2 , and R_3 of the reference are each C_1 - C_{11} alkyl groups for the Claim 3 genus group a) for each R , R^1 and R^2 species.

The chemicals are indicated to be combined with other materials including perfumes (col 4 lines 46-52). The compositions are indicated to be used for hair waving

(col 1 lines 65-68) and this terminology is taken as indicating uses for hair, as a body care product; compositions are also indicated to be free from any unpleasant odor and this is taken to indicate that the compositions employing the genus chemicals are intended to be used because they have a pleasant smell. {It should be noted that the reference does not indicate that the materials are free from odor.}

Further as to Claims 11, 13:

The reference does not further disclose employing chemicals in the Claim 11 genus.

However, Claims 11, 13 are rejected under 35 U.S.C. 103 as being obvious in accord with MPEP 2144.09 regarding Homology and Isomerism which states:

"Compounds which are position isomers (compounds having the same radicals in physically different positions on the same nucleus) or homologs (compounds differing regularly by the successive addition of the same chemical group, e.g., by -CH₂- groups) are generally of sufficiently close structural similarity that there is a presumed expectation that such compounds possess similar properties".

When the reference's genus {discussed above} employs substituents where R₁ is propyl, and when R₂ and R₃ are ethyl, a homolog of a chemical in the Structure Table for Claim 11 is indicated. The Structure Table chemical being 2nd to the bottom of page 6 of 20 in instant Claim 11 where when one of the amine alkyl groups is butyl instead of propyl.

The material would be expected to have inherent properties, including those identified by the Applicants. It is held that "Products of identical chemical composition can not have mutually exclusive properties." A chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure, the

properties applicant discloses and/or claims are necessarily present. *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990).

Further, the material with an additional methyl group would be expected, by one of ordinary skill in the art, to have a greater molecular weight and a corresponding reduction in vapor pressure.

It would have been obvious at the time of the invention for one of ordinary skill in the art to have further employed any of the materials or a homolog of the successful chemicals demonstrated by *Torii et al.* and mixed them in compositions comprising perfumes that are indicated to be used for successful body care products that have an inherent odor that is not unpleasant, with a reasonable expectation of success.

Claims 8 and 15 is rejected under 35 U.S.C. 103(a) as being obvious over *Karr Hunt et al.* (US 2060733), as applied to Claims 3, 5, and 10 above, and further in view of *Torii et al.* (US 3966903), along with *Kaiser* (US 4260526), in accord with claims 3 and 8 above.

The references of *Torii et al.* and *Karr Hunt et al.* {*Kaiser et al.* is taken as an informational supporting reference regarding expected ordinary skill in the art} are considered analogous art in that the each teach chemicals with structures comprised in the genus of both references.

Although *Karr Hunt et al.* discloses carbamate compositions comprising the materials of Figure 2, the reference does not further teach of employing materials in compositions applicable to home, body care, laundry or cosmetic products.

On the other hand, *Torii et al.* (col 4 lines 46-52 and col 1 lines 65-68) discloses compositions comprising fragrance materials that are employed with carbamates, According to Figure 1.

The compositions are indicated to be used for hair waving (col 1 lines 65-68) and this terminology is taken as indicating uses for hair, as a body care product; compositions are also indicated to be free from any unpleasant odor and this is taken to indicate that the compositions employing the genus chemicals are intended to be used because they enable a pleasant odor.

As both reference comprise materials are comprise material employed for hair or body care products, the compositions of *Karr Hunt et al.* would also be applicable to applications taught by *Torii et al.* for fragranced body care compositions.

It would have been obvious to one of ordinary skill in the art at the time of the invention to have employed an augmentation of analogous materials comprised of carbamate ester materials, with inherent fragrance properties as successfully employed by *Karr Hunt et al.*, to a fragranced body care compositions successfully employed by *Torii et al.*, with a reasonable expectation of success.

Response to Arguments

Arguments in regard to Claims 3, 5, 8, 10-11, 13, 15, 18-19 are moot; new grounds are applied.

In regard to argument concerning rejections of Claim 11 and 13, that employing a homolog would be expected to be the fact that applicant has recognized another

advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

A reduction in material vapor pressure would be expected to enable a material's effect and presence by remaining longer in the application.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action.

Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

This action is a final rejection and is intended to close the prosecution of this application. Applicant's reply under 37 CFR 1.113 to this action is limited either to an

appeal to the Board of Patent Appeals and Interferences or to an amendment complying with the requirements set forth below.

If applicant should desire to appeal any rejection made by the examiner, a Notice of Appeal must be filed within the period for reply identifying the rejected claim or claims appealed. The Notice of Appeal must be accompanied by the required appeal fee.

If applicant should desire to file an amendment, entry of a proposed amendment after final rejection cannot be made as a matter of right unless it merely cancels claims or complies with a formal requirement made earlier. Amendments touching the merits of the application which otherwise might not be proper may be admitted upon a showing a good and sufficient reasons why they are necessary and why they were not presented earlier.

A reply under 37 CFR 1.113 to a final rejection must include the appeal from, or cancellation of, each rejected claim. The filing of an amendment after final rejection, whether or not it is entered, does not stop the running of the statutory period for reply to the final rejection unless the examiner holds the claims to be in condition for allowance. Accordingly, if a Notice of Appeal has not been filed properly within the period for reply, or any extension of this period obtained under either 37 CFR 1.136(a) or (b), the application will become abandoned.

Examiner Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to AARON GRESO whose telephone number is (571)270-7337. The examiner can normally be reached on M-F 0730-1700.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on 571 272 1398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Milton I. Cano/
Supervisory Patent Examiner, Art Unit 1796

/Aaron J. Greso/